

Remarks

This Application has been carefully reviewed in light of the Office Action mailed May 28, 2004. Applicant appreciates the Examiner's consideration of the Application. To further clarify various limitations already recited in Applicant's claims, Applicant has amended Claims 1, 3-9, 13, 15-16, 17, 19-25, 29, and 31-34. These amendments are not considered narrowing or necessary for patentability. Applicant also respectfully provides these remarks. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. Information Disclosure Statements

Applicant mailed Information Disclosure Statements (IDSs) and accompanying PTO-1449 forms on December 22, 2000; December 31, 2001; February 13, 2002; March 1, 2002; April 18, 2003; July 23, 2003; and March 10, 2004. However, the references submitted with each of these IDSs were not indicated as having been considered by the Examiner in the Office Action. Additionally, Applicant mailed a Request for Consideration of an Information Disclosure Statement Timely Filed on June 21, 2004. Applicant respectfully requests the Examiner to indicate consideration of the submitted references by initialing next to each reference on each of the PTO-1449 forms. For the Examiner's convenience, copies of the IDSs and corresponding PTO-1449 forms are attached to this Response.

II. The Claims are Allowable over the Proposed *Chipman-Humphrey* Combination

The Examiner rejects Claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,038,668 to Chipman et al. ("*Chipman*") in view of U.S. Patent 5,987,233 to Humphrey ("*Humphrey*"). Applicant respectfully disagrees and discusses independent Claim 1 as an example.

A. The Proposed *Chipman-Humphrey* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

Independent Claim 1, as amended, recites:

A method for migrating product data within an electronic commerce system, comprising:
monitoring requests for product data by users of a global content

directory, the global content directory comprising:

a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class; and

one or more pointers associated with each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products associated with the product class;

identifying *the location of a particular user*;

determining, in response to monitoring *requests by the particular user*, that the product data requested by the particular user should be migrated from a seller database to *a storage location that is closer to the identified location of the particular user than the seller database*; and

initiating the migration of the product data *requested by the particular user* from the seller database *to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database*.

Chipman discloses a networked catalog search, retrieval, and information correlation and matching system, which allows suppliers to publish information in electronic catalogs and structure the information in an object oriented representation distributed across a network of computers. (Abstract) Even assuming for the sake of argument that *Chipman* disclosed the limitations of Claim 1 asserted by the Examiner (which Applicant does not concede), *Humphrey* would still fail to make up for the acknowledged deficiencies of *Chipman*.

With respect to the deficiencies of *Chipman*, the Examiner states, "Although *Chipman et al.* discloses the migration of this directory structure to a storage location remote from the seller, *Chipman et al.* fails to explicitly disclose that this migration occurs based upon monitoring requests by the user and initiating the migration of the product data from the seller database to the storage location." (Office Action, Page 3) Thus, *Chipman* fails to disclose, teach, or suggest at least the following limitations as recited in Claim 1:

- identifying *the location of a particular user*;
- determining, in response to monitoring *requests by the particular user*, that the product data requested by the particular user should be migrated from a seller database to *a storage location that is closer to the identified location of the particular user than the seller database*; and
- initiating the migration of the product data *requested by the particular user* from the seller database *to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database*.

Humphrey fails to make up for these deficiencies of *Chipman*.

Humphrey discloses a comprehensive global information network broadcasting system and implementation thereof that is designed to provide a plurality of internet service providers (ISPs) with updated information through the use of high speed satellite links directly to the local ISP from a centralized location. (Abstract) The satellite broadcasting system is combined with servers known as caching or proxy servers located at the client site which serve to store web and other data until the end user needs to access the data and a master cache center which coordinates the selection and transmission of information to those client sites via the satellite broadcasting system. (Abstract)

More particularly, *Humphrey* discloses that a customer of an ISP sends a message to a local ISP's cache system requesting information or data, and the local ISP's cache checks whether it has the current version of the information or data stored on its cache. (Column 5, Lines 1-5) After some additional steps (including determining that the local ISP's cache adapter does not have the requested information or data), the local ISP's cache searches other caches or the Internet for the information. (Column 5, Lines 5-11) The cache adapter sends a message over the Internet to the master caching center regarding the "miss" of the requested information. (Column 5, Lines 11-14) The master cache records all the information regarding the miss and measures the amount of interest in the information or data from the local caching systems. (Column 5, Lines 14-17) "The master cache has a software program that determines at what point the level of interest is sufficient to broadcast the information or data *to all the ISPs, whether or not they have requested the information.*" (Column 5, Lines 17-21; emphasis added and reference numerals omitted)

To "measure the amount of interest," the master cache center "analyzes the miss data from all the local cache sites and determines the information and data *that are of a sufficient interest to the internet community*, using the companion software program to do so." (Column 6, Lines 13-17) This determines the information and data that warrants having the information and data sent by means of the satellite connection *and thus being placed in all of the local cache sites in the system.* (Column 6, Lines 17-20)

Humphrey further states:

The novel method of operating a complete comprehensive internet broadcasting system 50 which uses the following steps in its process: receiving a request for information and data from a customer to the local cache site 51; determining the location by the local cache site of the requested information or data from a number of locations sources 52; notifying the master cache center of the lack of success in finding the requested data or information in the local cache 53; ***analyzing the number of requests that the master cache has received on a particular piece of information or data 54***; retrieving the data or information from the internet 55; and sending the requested information or data through the satellite broadcasting system ***to all the local cache sites once the data or information requested has reached a predetermined level 56***.

(Column 5, Lines 49-63)

However, at a minimum, *Humphrey* fails to disclose, teach, or suggest “***identifying the location of a particular user,***” “determining, in response to monitoring ***requests by the particular user,*** that the product data requested by the particular user should be migrated from a seller database to ***a storage location that is closer to the identified location of the particular user than the seller database,***” and “initiating the migration of the product data ***requested by the particular user*** from the seller database to ***the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database,***” as recited in Claim 1 as amended.

For example, *Humphrey* fails to disclose, teach, or suggest “identifying the location of a particular user,” as recited in Claim 1 as amended. Indeed, *Humphrey* does not disclose, teach, or suggest that its system is concerned with the location of a particular user. Rather, *Humphrey* discloses that its system merely “analyzes the miss data ***from all the local cache sites*** and determines the information and data that are of a sufficient interest ***to the internet community,*** using the companion software program to do so,” and “***broadcast[s]*** the information or data ***to all the ISPs, whether or not they have requested the information.***”

As another example, *Humphrey* fails to disclose, teach, or suggest “determining, in response to monitoring requests by the particular user, that the product data requested by the particular user should be migrated from a seller database to a storage location closer to the identified location of the particular user than the seller database,” as recited in Claim 1 as

amended. Instead, *Humphrey* clearly discloses that its system “analyzes the miss data *from all the local cache sites* and determines the information and data that are of a sufficient *interest to the internet community*, using the companion software program to do so” and “*broadcast[s]* the information or data *to all the ISPs, whether or not they have requested the information.*” Such a determination is made without regard to any particular user or “a storage location closer to the identified location of the particular user,” as recited in Claim 1 as amended.

As yet another example, at least because *Humphrey* fails to disclose, teach, or suggest the above-discussed limitations as specifically recited in Claim 1 as amended, *Humphrey* necessarily fails to disclose, teach, or suggest “initiating the migration of the product data *requested by the particular user* from the seller database to *the storage location determined for the particular user,*” as recited in Claim 1 as amended.

For substantially similar reasons to those discussed above with reference to independent Claim 1, Applicant respectfully submits that the proposed *Chipman-Humphrey* combination fails to disclose, teach, or suggest various limitations recited in independent Claim 17.

Independent Claims 33-34 recite certain patentable distinctions substantially similar to those recited in independent Claims 1 and 17. In addition, independent Claims 33-34 recite further patentable distinctions over the proposed *Chipman-Humphrey* combination. Applicant discusses independent Claim 33 as an example. At a minimum, the proposed *Chipman-Humphrey* combination fails to disclose, teach, or suggest “instructing the seller database to” perform the following limitations, as recited in Claim 33 as amended:

- copy the *product data requested by the particular user* for caching *at the storage location determined for the particular user*;
- create *a pointer to the storage location determined for the particular user*; and
- *update the migrated product data using the pointer when the product data is updated in the seller database.*

As noted above, neither *Chipman* nor *Humphrey* disclose, teach, or suggest performing certain functions with respect to “the particular user,” as recited in Claims 1 and

17 (and similarly in Claim 33). For example, the proposed *Chipman-Humphrey* combination fails to disclose, teach, or suggest “determining, in response to monitoring requests by the particular user, that the product data requested by the particular user should be migrated from a seller database to a storage location closer to the identified location of the particular user than the seller database based on the number of times the particular user has requested the product data within a specified period of time,” as recited in Claim 33. Thus, the proposed *Chipman-Humphrey* combination necessarily fails to disclose, teach, or suggest instructing the seller database to “copy the *the product data requested by the particular user* for caching *at the storage location determined for the particular user*,” as recited in Claim 33. Similarly, the proposed *Chipman-Humphrey* combination fails to disclose, teach, or suggest instructing the seller database to “create *a pointer to the storage location determined for the particular user*,” as recited in Claim 33.

Moreover, the proposed *Chipman-Humphrey* combination fails to disclose, teach, or suggest instructing the seller database to “*update the migrated product data using the pointer when the product data is updated in the seller database*,” as recited in Claim 33. As discussed above, with reference to Claims 1 and 17, *Chipman* fails to disclose, teach, or suggest “determining, in response to monitoring requests by the particular user, that the product data requested by the particular user should be migrated from a seller database to a storage location closer to the identified location of the particular user than the seller database based on the number of times the particular user has requested the product data within a specified period of time,” as also recited in Claim 33. The Examiner apparently relies on *Chipman* as disclosing instructing the seller database to “*update the migrated product data using the pointer when the product data is updated in the seller database*,” as recited in Claim 33. However, at least because *Chipman* does not disclose, teach, or suggest the migrated product data (i.e. determining, in response to monitoring requests by the particular user, that the product data requested by the particular user that is determined, in response to monitoring requests by the particular user, should be migrated from a seller database to a storage location closer to the identified location of the particular user than the seller database based on the number of times the particular user has requested the product data within a specified period of time), *Chipman* necessarily fails to disclose, teach, or suggest instructing

the seller database to “*update the migrated product data using the pointer when the product data is updated in the seller database*,” as recited in Claim 33.

For substantially similar reasons to those discussed above with reference to independent Claim 33, Applicant respectfully submits that the proposed *Chipman-Humphrey* combination fails to disclose, teach, or suggest various limitations recited in independent Claim 34.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 17, and 33-34 and their dependent claims.

B. The Proposed *Chipman-Humphrey* Combination is Improper

As discussed above, Applicant respectfully submits that the proposed *Chipman-Humphrey* combination fails to disclose, teach, or suggest all the limitations recited in Applicant's claims. Moreover, Applicant respectfully submits that the rejection of Applicant's claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Chipman*, *Humphrey*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify *Chipman* or *Humphrey* in the manner the Examiner proposes. The rejected claims are allowable for at least this additional reason.

Applicant respectfully submits that the Examiner's assertion that it would have been obvious to combine the teachings of *Chipman* with the teachings of *Humphrey* to arrive at Applicant's invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a). Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have

been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120,

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which

only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

With regard to the proposed *Chipman-Humphrey* combination, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Chipman et al. and include the ability to migrate product data from sellers' databases to storage locations closer to the user that requested the information as taught by Humphrey. Humphrey provides motivation by indicating that this would alleviate the problem of the Internet choking itself with replicated data by moving many copies of the same data around at any given moment in time (Col. 1, lines 50-53) and further that this method would better serve the end user and is desirable and necessary for efficient and effective use of shared data by multiple users when it is determined that there is sufficient interest in the particular data or information (Col. 3, lines 1-6; Col. 5, lines 13-20; Col. 6, lines 21-36).

(Office Action, Page 3) Applicant respectfully submits that the Examiner has not pointed to any portions of either *Chipman* or *Humphrey* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the system, method, and medium for retrieving, organizing, and utilizing networked data disclosed in *Chipman* with the global information network broadcasting system disclosed in *Humphrey*. Instead,

Applicant respectfully submits that the Examiner has merely pointed to a portion of *Humphrey* that describes its advantages. However, this cited portion fails to establish that it would have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to even attempt* to incorporate into the system, method, and medium for retrieving, organizing, and utilizing networked data disclosed in *Chipman* a global information network broadcasting system as disclosed in *Humphrey*. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to actually* incorporate into the system, method, and medium for retrieving, organizing, and utilizing networked data disclosed in *Chipman* such global information network broadcasting system as disclosed in *Humphrey*, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Chipman* with *Humphrey* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicant respectfully submits that the Examiner's proposed combination of *Chipman* with *Humphrey* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicant's claims and is unsupported by the teachings of *Chipman* and *Humphrey*. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 17, and 33-34 and their dependent claims.

III. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the *Chipman* and *Humphrey* references. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By

not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the obviousness rejections.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Applicant believes no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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